

### Remarks

The present application was filed October 31, 2001 with original claims 1-30. The Office Action (Paper No. 5) mailed December 18, 2003 rejected claims 1-14, 16, 17, 19, 20, 22-27, 29 and 30, objected to claims 15, 18, 21, and 28. Claims 2, 4, 7, 12 and 25 have been amended to broaden the scope of the claimed invention, and to more particularly point out and distinctly claim that which the Applicant considers to be the subject matter of the present invention. Particularly, the amendments to these claims do not narrow the claim scope in view of a rejection over prior art.

### Rejection of Claims Under 35 U.S.C. §102(e)

The Office Action rejected claims 1-14, 16, 17, 19, 20, 22-27, 29, and 30 as being anticipated by U.S. Patent No. 5,162,955 issued to Burdenko ("Burdenko '955"). This rejection is respectfully traversed.

#### Claim 1

First, Burdenko '955 does not disclose or suggest the recited limitation "a support element...to unload the servowriter head from the data surface...." The Examiner erroneously reads the suspension arm 62 of Burdenko '955 onto the support element of claim 1. The suspension arm 62 does not in any way unload the servowriter head. In fact, the suspension arm 62 acts in direct opposition to a support element that would have to overcome the bias force of the suspension arm 62 in order to unload the servowriter head.

Furthermore, Burdenko '955 does not disclose or suggest the recited limitation "a support element configured to allow sliding contact with the actuator to unload the servowriter head from the data surface...." Even in the Examiner's construction, wherein the suspension arm 62 cannot reasonably anticipate the support element, the suspension arm 62 does not slidingly contact the actuator; rather, the suspension arm 62 is fixed at one end thereof to the actuator 66.

Furthermore, Burdenko '955 does not disclose or suggest the recited limitation of "an actuator configured to support a servowriter head between the discs...." A plain reading of Burdenko '955 reveals the disclosure is limited to a device for writing dedicated servo information (see Burdenko '955, col. 3 lines 28-31), and not the embedded servo information of the present invention as claimed in claim 1.

Furthermore, claim 1 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified the recited “means” element to cover at least the disclosed actuator 320 and the support structure 310 which operate as disclosed such that the support structure 310 supportingly engages the distal end of the actuator continuously as both members are rotated clearing away from the discs.

The Examiner is accordingly obliged *as a matter of law* to construe the recited “means” element as this corresponding structure and equivalents thereof. See *In re Donaldson Company, Inc.*, 16 F.3d 1189 (Fed.Cir.1994)(*en banc*); *B. Braun Medical v. Abbott Lab.*, 43 USPQ2d 1896 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510 (June 21, 2000). Failure to do so constitutes reversible error.

When this means element is properly construed, it is clear that Burdenko ‘955 fails to disclose this element. As discussed above, Burdenko ‘955 is silent regarding a support element for unloading the head from the disc. Accordingly, Burdenko ‘955 is likewise silent regarding means for retracting a support element.

For at least these reasons, Burdenko ‘955 cannot sustain the Section 102 rejection because it does not disclose all the recited elements of the present invention as claimed in claim 1. Accordingly, the Applicant respectfully submits that the rejection of claim 1 as being anticipated by Burdenko ‘955 is erroneous as a matter of law, and requests withdrawal of the rejection and allowance of claim 1 and the claims depending therefrom.

### Claim 13

As discussed above, Burdenko ‘955 does not disclose or suggest at least the following elements of claim 13: “moving the actuator...by sliding the actuator onto an engagement surface of a support element...”; “moving the support element...as the actuator slides on the engagement surface...”; and “removing the first and second discs from the stack.” For at least these reasons, Burdenko ‘955 cannot sustain the Section 102 rejection because it does not disclose all the recited elements of the present invention as claimed in claim 13. Accordingly, the Applicant respectfully submits that the rejection of claim 13 as being anticipated by Burdenko ‘955 is erroneous as a matter of law, and requests withdrawal of the rejection and allowance of claim 13 and the claims depending therefrom.

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### **Rejection of Claims Under 35 U.S.C. §112 First Paragraph**

The Office Action rejected claims 2, 4, 7, 12, and 25 as failing to comply with the written description requirement. This rejection is respectfully traversed; nevertheless, broadening amendments have been made obviating the rejection.

Support is found in paragraph [0027] of the specification that the Applicant had possession of subject matter supporting claims drawn to the support element being elongated enough to extend by a distance greater than  $R/10$ , where  $R$  is the nominal disc radius 119. The claimed distance  $R/6$  is greater than  $R/10$  and is thereby within subject matter in the possession at the time of filing. Nevertheless, the Applicant has amended the claims to recite the broader term  $R/10$  that is explicitly stated in the specification. These claims have thus been amended to broaden the scope of the claimed invention, and to more particularly point out and distinctly claim that which the Applicant considers to be the subject matter of the present invention. Particularly, the amendments to these claims do not narrow the claim scope in view of a rejection over prior art. Reconsideration and withdrawal of the present rejection are respectfully requested.

### **Allowed Claims and Allowable Subject Matter**

The Applicant gratefully acknowledges the indication of allowable subject matter in claims 15, 18, 21 and 28. For the reasons above, however, the broader independent claims from which these claims depend are allowable. As such, the Applicant has elected not to place these dependent claims in independent form.

### **Request for Telephone Interview**

The Applicant hereby requests, with requisite interview request form filed herewith, a telephone interview at such time when the Examiner has reviewed this Amendment and before such time when the Examiner responds with an action on the merits. The interview is necessary to clarify potential unresolved issues in the Examiner's construction of the support element of the present invention for unloading a head as being anticipated by a prior art device that simply does not disclose or suggest a device for unloading the heads whatsoever. The Applicant is at a loss as to how the Examiner's claim construction is reasonable. The rejections appear, as understood, to be based on reading the present invention onto the contact-start-stop apparatus of the cited reference for in-situ servowriting, which the Applicant believes to be erroneous as a

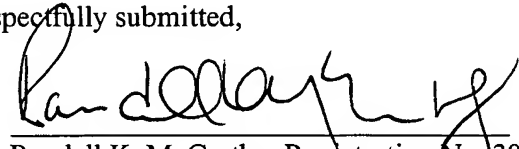
matter of law. The interview is necessary to facilitate prosecution on the merits for an invention that has proven to be of significant commercial value.

**Conclusion**

This is a complete response to the Office Action mailed December 18, 2003. The Applicant respectfully requests that the Examiner enter the above amendments, reconsider the application and allow all of the pending claims. The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response.

Respectfully submitted,

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